

S/N 09/840,982

REMARKS

Claims 1-2, 5, and 7 are currently pending in the application.

CLAIM REJECTION UNDER 35 U.S.C. §103(a)

In the Action, the Examiner has rejected claims 1, 2, 5 and 7 as being unpatentable over U.S. Patent No. 6,017,981 (the '981 patent).

Applicant respectfully traverses this rejection on the basis that the '981 patent is not proper prior art against the instant application and that a prima facie case of obviousness has not been established.

Specifically, the instant application is a national phase application of PCT application number PCT/EP99/08059, which claims earliest priority to DE 198 49 313.4, which was filed October 26, 1998.

The '981 patent is a publication of international application PCT/DE96/00069, which was filed January 11, 1996. The 35 U.S.C. §371 date for the '981 patent is September 17, 1998, as indicated on the face of the patent.

The '981 patent is not proper prior art under either 35 U.S.C. §§102(a) or (e), because the reference has the same inventorship as the instant application and therefore is not by another.

The '981 patent is not proper prior art under 35 U.S.C. §102(b), because the invention was not patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the instant application for patent in the United States. The earliest effective filing date of the instant application, as noted above, is October 26, 1998, which is less than one year after the '981 patent's §371 date of September 17, 1998.

The '981 patent is not proper prior art under § 102 (d), since the invention which is the subject of the instant application was not first patented or caused to be patented, nor was it the subject of an inventor's certificate, by Applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the instant application in the United States.

Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claims 1, 2, 5 and 7 under 35 §103(a) as being unpatentable over U.S. Patent No. 6,017,981.

Applicant, in the attached Information Disclosure Statement, brings to the Examiner's attention WO 96/22337 (in German), which is the PCT publication of the '981 patent. Applicant will address the above rejection on the basis that the Examiner withdraws said rejection and makes a new rejection using WO 96/22337 (WO '337) as the reference. Applicant assumes that the '981 patent will serve as evidence of the teachings of the WO '337 reference.

Applicant submits that WO '337 is directed to a coating material for use as an interior and exterior wall paint for housing structures and the like. This coating material should be of a bright tone or white in the visible range of the electromagnetic spectrum of 0.4 to 0.7 μm . However, in the near-infrared range of 0.7 to 2.5 μm , the coating material of WO '337 is absorbent in order to warm the housing structure during times of colder temperatures, e.g., during the winter months, for example. See, the '981 patent at col. 1, line 66 to col. 2 line 13. These properties are achieved by the compositions of WO '337 themselves and especially by the second particles, which have a transparency greater than 40% only in the wavelength ranges of from 0.4 to 0.7 μm and an absorption greater than 20%, preferably greater than 40%, in the wavelength of from 1.0 to 2.0 μm .

In contrast, the instantly claimed subject matter provides for dark toned coating materials having a low absorption of sunlight.

These coatings are designed for the front deposit surface (dash board) of motor vehicles, and therefore must be of a dark color to prevent reflection on the inner surface of the windshield and consequently cause obstruction to the driver's view. However, the dark tinted coatings previously known and used to coat dashboard surfaces have the disadvantage of absorbing sunlight and radiating heat out in all directions. See, instant application at pages 1-2.

This problem has been solved by the instant subject matter by providing for a coating material which comprises pigments having an absorption of 40% or more in the visible light range of 0.35 to 0.7 μm and a back scatter of 40% or more in the near-infrared range 0.7 to 2.5 μm . As such, the instant subject matter absorbs less sunlight and is resultantly less hot than the coating described in WO '337. Further evidence in support of this is shown in Figure 1 of the instant application, wherein shown is a low reflection of about 10% in the visible light range and a very high reflection of greater than 80 % in the near-infrared range for a coating material falling within the scope of the presently claimed compositions.

The Examiner has repeatedly stated that it would have been obvious to one of ordinary skill in the art to pick and chose various components based upon their characteristics in order to obtain the instantly claimed subject matter. However, the Examiner has provided no evidence of motivation to do so or reason one would

expect success in doing so. While the Examiner has cited myriad references, which purport to show the level of one of skill in the art, etc. The Examiner has failed to provide one direct citation to any of these six references, which would directly evidence this assertion. On these bases Applicant asserts that a prima facie case of obviousness has not been established.

Finally, Applicant, in closing, reminds the Examiner that the Examiner may be required to cite cited art not previously cited in the next office action. Therefore, in accordance with MPEP Section 706.07(a), the next action should not be made final.

CONCLUSION

If the Examiner has any questions or wishes to discuss this matter, he is welcomed to contact the undersigned attorney.

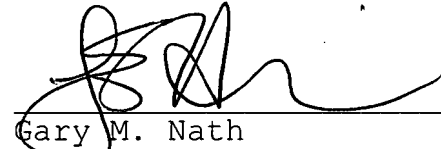
Respectfully submitted,

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